

### SECTION III—REMARKS

This amendment is submitted in response to the Office Action mailed November 21, 2003. Claim 10 is amended to more clearly recite features of the claimed invention. Claims 10 and 12-18 remain pending in the application. Applicants respectfully request reconsideration of the application and allowance of all pending claims in view of the above amendments and the following remarks.

#### Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 10 and 12-18 under 35 U.S.C. § 103(a) as obvious in view of, and therefore unpatentable over, U.S. Patent No. 5,900,610 to Kelly, Jr. ("Kelly") in view of U.S. Patent No. 5,227,617 to Christopher et al ("Christopher"). Applicant respectfully traverses the Examiner's rejections. To establish a *prima facie* case of obviousness, three criteria must be met: (1) the prior art references must teach or suggest all the claim limitations; (2) some suggestion or motivation to combine the references must be found in the prior art; and (3) there must be a reasonable expectation of success. MPEP § 2143. As explained below, the Examiner has not established a *prima facie* case of obviousness because criteria (1) and (2) have not been met.

Kelly discloses an apparatus and method for tracking inventory of multiple goods in multiple shipping cartons. Specifically, Kelly describes a system for tracking shoe inventory. Each pair of shoes is packed within a shoe box 20, and a plurality of shoe boxes 20 are then packed into a shipping carton 24. A main label 30 is permanently applied to shoe boxes 20. The main label 30 has a single secondary label 40 thereon and is configured to be placed around a corner of the shoe box 20, such that an end portion or tab 56 of secondary label 40 extends outwardly and is grippable by a worker; this allows the worker to peel off the secondary label 40 and separate it from the main label 30, which remains attached to the shoe box. At a distribution center, the labeled shoe boxes 20 are sent down a production line in a known sequence of styles and sizes, and in groups bound for particular destinations. Each of the groups is packed in one or more cartons 24. The workers pack the cartons 24 in the order in which the shoe boxes 20 are transported down the line and then remove the secondary label 40 from the last shoe box 20 placed in the carton 24 and apply the removed secondary label 40 to the carton 24.

Claim 10, as amended, recites a method including “reading a unique identifier stored on a component,” “printing the unique identifier read from the component onto first and second labels,” and “removably affixing the first and second labels to a component container into which the component is inserted.” Kelly and Christopher, taken together, do not disclose, teach or suggest all of the recited limitations. Kelly discloses that a main label having a single secondary label is attached to the exterior of a shoe box, and that only the single secondary label can be removed from the shoe box and placed on a shipping carton into which the shoe box is placed. Because Kelly teaches that the main label is permanently attached to a shoebox and only the single secondary label is removable from the main label, it cannot disclose, teach or suggest a method combination including “removably affixing the first and second labels to a component container into which the component is inserted.” Similarly, Christopher does not disclose “printing the unique identifier read from the component onto first and second labels,” nor does it disclose “removably affixing the first and second labels to a component container into which the component is inserted.” Kelly and Christopher therefore cannot obviate claim 10 because, whether taken alone or together, they do not disclose, teach or suggest every element and limitation of the claim. Applicant therefore respectfully requests withdrawal of the rejection and allowance of the claim.

Regarding claims 12-18, if an independent claim is allowable, then any claim depending therefrom is also allowable. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 10 is in condition for allowance. Applicant thus submits that claims 12-18 are allowable by virtue of their dependence on allowable claim 10 and by virtue of the features recited therein. Applicant therefore respectfully requests withdrawal of the rejections and allowance of these claims.

### Conclusion

Given the above amendments and accompanying remarks, independent claim 10 is now in condition for allowance. The dependent claims that depend directly or indirectly on this independent claim are likewise allowable based on at least the same reasons and based on the recitations contained in each dependent claim.

If the undersigned attorney has overlooked a teaching in any of the cited references that is relevant to allowance of the claims, the Examiner is requested to specifically point out where

such teaching may be found. Further, if there are any informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (206) 292-8600.

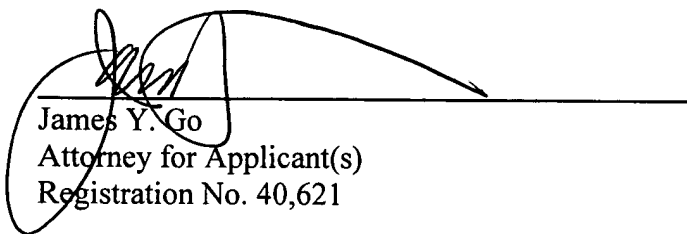
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Respectfully submitted,

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Date: 2-28-04



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